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10/675,468

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EXAMINER

RYAN, PATRICK A

ART UNIT

PAPER NUMBER

2623

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,468	<b>Applicant(s)</b> KARAOGUZ ET AL.	
	<b>Examiner</b> PATRICK A. RYAN	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 22, 2008 has been entered.
2. This Office Action is made in response to "RCE-Replay to Final Office Action of 04/01/2008" (Reply) filed May 22, 2008. Applicant has amended Claims 1, 11, and 21; and no claims have been added or withdrawn, as of May 22, 2008. As amended, Claims 1 through 31 are presented for examination.

### ***Response to Arguments***

3. Applicant's arguments, see Pages 15 and 16, filed January 3, 2008, with respect to the rejection(s) of claim(s) 1, 1, and, 21 under 35 USC 102(e) as being anticipated by Boston (US Patent 7,212,730) regarding the limitation "scheduling based on input from a user provided after said displaying of said notification" have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Oh (US PG PUB 2002/0161713 A1) as addressed below.

4. Applicant's arguments, see Pages 13-15, filed January 3, 2008, with respect to the rejection of Claims 1, 11, and 21 under 35 USC 102(e) as being anticipated by Boston (US Patent 7,212,730) have been fully considered but they are not persuasive.

Applicant submits that Boston does not disclose or suggest at least the limitation of "automatically displaying a notification of the advertisement on said television, after said receiving of the advertisement" because Boston provides notification to the user by way of on-screen guide 1400, "which appears only when it is requested by the user, i.e., when the user presses a key (or keys) in the DVR's remote control" (with reference to Reply Page 14 and Boston Col. 13 Lines 17-24). The Examiner respectfully disagrees.

It is the Examiners position that "automatically displaying" does not preclude user interaction. The "notification" in Boston is produced in response to the user's activation of the program guide, but the user's activation of the program guide does not directly result in the production of a notification. Boston discloses in Col. 13 Lines 22-25 that "When the guide is requested, the system determines an "anchor" position from which to start the guide" where the "anchor position" is the highlighted notification of a sponsored program. As quoted from Boston above, the system (not the user) determines the anchor position to be displayed in the program guide. Therefore, the Examiner presents that Boston does in fact teach the limitation "automatically displaying a notification of the advertisement on said television, after said receiving of the advertisement" as recited in Claims 1, 11, and 21.

5. Applicant's arguments, see Pages 17-18, filed January 3, 2008, with respect to the rejection of Claims 4, 14, and 24 under 35 USC 102(e) as being anticipated by Boston (US Patent 7,212,730) have been fully considered but they are not persuasive.

Applicant submits that Boston does not teach the limitation "establishing a user profile indicating at least a particular type of advertisement that is to be received" because Boston's "user profile 300 includes only information regarding age, gender, marital status, race, religion, income, hobbies, home address information, home phone, and DVR preferences" (with reference to Reply Page 17 and Boston Fig. 3 depicting the user's profile). The Examiner respectfully disagrees.

Boston's User Profile 300, of Fig. 3, is used to establish the User Profile – Program Preferences 400, of Fig. 4, as described in Col. 5 Lines 35-67 and Col. 6 Lines 1-54. In other words, a user characteristic such as age can be used to indicate the rating of content the user would prefer (Age 310 corresponding to Rating 410, as described in Col. 6 Lines 4-9). In addition, the user's listed hobbies can be used to indicate the types or genres of content the user would prefer to watch (Hobbies/Interests 360 corresponding to Genre 430, as described in Col. 6 Lines 20-29). Therefore, the Examiner presents that Boston does in fact teach the limitation "establishing a user profile indicating at least a particular type of advertisement that is to be received" as recited in Claims 4, 14, and 24.

6. Applicant's arguments, see Pages 18-19, filed January 3, 2008, with respect to the rejection of Claims 6, 16, and 26 under 35 USC 102(e) as being anticipated by Boston (US Patent 7,212,730) have been fully considered but they are not persuasive.

Applicant submits that Boston does not teach the limitation "identifying a gap that exists in a schedule in a channel guide displayed on said television" because Fig. 8 of Boston "decision 835 is used as part of a timer that determine whether or not a commercial has to be recorded". Applicant further submits that Boston's Fig. 8 "does not relate to identifying a gap that exists in a channel guide schedule displayed on a television" and "does not disclose any processing performed with regard to a channel guide that is displayed on a television" (with reference to Reply Page 19). The Examiner respectfully disagrees.

The Examiner presents that Step 835 of Boston is a determination of whether or not it is time for a commercial break. Commercial break times, as part of Edit Schedule 815, are retrieved in Step 810 and used in Step 835 to insert a commercial at the indicated time (as Boston describes in Col. 8 Lines 52-67 and Col. 9 Lines 1-10). Therefore, Boston identifies "gaps" in the programming when a determination of a commercial break is made in Step 835 based on time information in Edit Schedule 815. In addition, the Edit Schedule 815 of Boston is shown in Fig. 12 as a program guide with the commercial breaks identified (Commercial-1 and Commercial-2, as described in Col. 12 Lines 4-32). The Examiner therefore presents that Boston teaches the limitation "identifying a gap that exists in a schedule in a channel guide displayed on said television" as recited in Claims 6, 16, and 26.

7. Applicant's arguments, see Pages 20-22, filed January 3, 2008, with respect to the rejection of Claims 8, 18, and 28 under 35 USC 103(a) as being anticipated by Boston (US Patent 7,212,730) in view of Oh (US PG PUB 2002/0161713 A1) have been fully considered but they are not persuasive.

8. Applicant submits that the combination of Boston and Oh does not teach the limitation "granting permission to schedule said at least one advertisement for display within said identified gap" because "Oh simply discloses that the system 100 may ask the user whether or not the user will watch advertisement content that has just been retrieved" (with reference to Reply Page 21). The Examiner respectfully disagrees.

9. The Examiner presents that Oh also teaches allowing the user to schedule an advertisement for later viewing, as Oh discloses in Paragraph [0030]:

"...the present invention can also be applicable to a case where the multiple media content is played at a desired time designated by the user after the data stream of the multimedia content is received and stored on the client 130".

Therefore, the Examiner presents that the combination of Boston and Oh teach the limitation "granting permission to schedule said at least one advertisement for display within said identified gap" as recited in Claims 8, 18, and 28.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 through 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Oh (US PGPUB 2002/0161713 A1).

12. In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising automatically receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4); display a notification of the advertisement on said television, after said receiving of the advertisement (highlighted selection 1420 of Figure 14, as described in Col. 13 Lines 37-39; with further reference to Col. 13 Lines 26-35);

Boston teaches scheduling, based on times designated by content provider, an advertisement for viewing at the user's location (step 945 of Figure 9 described in Col 9 Lines 58-61); and displaying media corresponding to at least a portion of said scheduled advertisement (step 935 of Figure 9 described in Col. 9 Lines 55-58) on said television based on said scheduling, but does not teach scheduling based on input from a user provided after said display of said notification.



In a similar field of invention, Oh teaches a method (Fig. 3) and processor (Fig. 2a and 2b) for allowing a user to schedule a advertisement to be played at a desired time designated by the user after a data stream of multimedia content is received and stored on a client device (as described in Paragraphs [0029-0030]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combined the teaches of Boston regarding the presentation of the availability of advertisement content, with Oh's teachings of allowing a user to schedule a received advertisement for display at a later time, so that a user may be provided with a greater amount of control and flexibility over program content such as with video on demand systems, as Oh discloses in Paragraph [0002].

13. In reference to claims 2 and 22, the combination of Boston and Oh teach a method of and processor for presenting data representative of said received advertisement (Figure 12 described by Boston in Col. 12 Lines 18-20) in an available slot in a channel guide (detailed edit schedule 1200 of Figure 12 described by Boston in Col.12 Lines 4-12).

14. In reference to claims 3 and 23, the combination of Boston and Oh teach a method of and processor for displaying data representative of said received advertisement where the advertisement is one or more of graphical data, textural data, audio data and video data (disclosed by Boston in Col. 2 Lines 56-65).

15. In reference to claims 4 and 24, the combination of Boston and Oh teach a method of and processor for establishing a user profile (Figures 3 and 4 described by Boston in Col. 5 Lines 35-67 and Col. 6 Lines 1-54) indicating at least a particular type

of advertisement that is to be received (detailed edit schedules 610 described by Boston in Col. 6 Lines 60-63).

16. In reference to claims 5 and 25, the combination of Boston and Oh teach a method of and processor for determining whether data representative of said particular type of advertisement is within said established profile (step 840 of Figure 8 described by Boston in Col.9 Lines 4-10); and if said data representative of said particular type of advertisement is within said established profile, receiving said particular type of advertisement (step 860 of Figure 8 described by Boston in Col.9 Lines 10-12).

17. In reference to claims 6 and 26, the combination of Boston and Oh teach a method of and processor for identifying a gap that exists in a schedule in a channel guide displayed on said television (step 835 of Figure 8 described by Boston in Col 8 Lines 52-67 and Col. 9 Lines 1-16; with further reference to Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32).

18. In reference to claims 7 and 27, the combination of Boston and Oh teach a method of and processor for scheduling at least one advertisement for display at a time corresponding to said identified gap (decision 1040 of Figure 10 described by Boston in Col. 10 Lines 44-48).

19. In reference to Claims 8, 18, and 28, Boston does not teach a method for granting permission to schedule at least one advertisement for display within said identified gap. However, Oh, in a similar field of invention, teaches a method of inquiring from a user if he/she will watch at least one of the advertisement contents presented and teaches that the user may schedule the received advertisement for

display at a later time (as disclosed in Paragraph 0047 Lines 1-3; with further reference to Paragraph 0030).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion disclosed by Boston to incorporate a method of granting permission to schedule an advertisement for display to the user. It would be advantageous to have an advertising system that required the permission of the user to display a give advertisement because a user's interaction with the advertisement would suggest that the user has a true desire to view the advertisement and would therefore be more likely to view additional program content and related advertisements (as Oh describes in Paragraph 0011).

20. In reference Claims 9, 10, 19, 20, 29, and 30 Boston does not teach a method for offering a reward for scheduling the advertisement for display within a personal advertisement channel. In addition, Boston does not teach a method where said reward comprises at least one of free programming and reduced programming cost. However, Oh teaches a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental fashion dependent upon when the user elects to view the given advertisement (as disclosed in Paragraph 0054). In addition, if the user elects to view the advertisement while the multimedia content is being played, the system provides the said multimedia content for free (as disclosed in Paragraph 0054 Lines 8-12).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion disclosed by Boston to incorporate a method discounting programming content based on the event of a user scheduling an advertisement to be viewed. It would be advantageous to have an advertising system that rewarded the user for scheduling an advertisement for viewing because the user would be more likely to view additional program content and related advertisements in exchange for free or reduced cost programming (as Oh describes in Paragraph 0011).

21. In reference to claims 11, 12, 13, 14, 15, 16, and 17, the combination of Boston and Oh teach a machine-readable storage having stored thereon, a computer program having at least one code section for providing an advertisement in a communication network (disclosed by Boston in Col. 25 Lines 16-25), the at least one code section being executable by a machine (disclosed by Boston in Col. 25 Lines 25-27) for causing the machine to perform the method of claims 1 through 10, as rejected above.

22. In reference to claim 21, the combination of Boston and Oh teach a system for providing an advertisement in a communication network (system diagram shown in Figure 6 as described by Boston in Col. 6 Lines 55-63).

23. In reference to claim 31, the combination of Boston and Oh teach a processor that is a media management system processor (processor 3000 of Figure 30 disclosed by Boston in Col 24 Lines 1-5).

***Conclusion***

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./  
Examiner, Art Unit 2623  
Tuesday, July 15, 2008

/Scott Beliveau/  
Supervisory Patent Examiner, Art Unit 2623